

REMARKS

Claims 1-2, 4-9, and 11-20 remain in the present application. Claims 3 and 10 have been cancelled. Claims 1, 5, 13, and 15 have been amended to provide proper antecedent basis. No new matter has been added. No additional claims fee is believed to be due.

Rejection Under 35 U.S.C. §101

Claims 3 and 10 were finally rejected under 35 U.S.C. §101 because the claimed recitation of a use without setting forth any steps involved in the process results in an improper definition of a process. Applicants have canceled Claims 3 and 10 herein.

Objections to the Drawings

The Examiner has disapproved the proposed substitute sheets of drawings filed May 22, 2003. In particular, the Examiner stated that an incomplete set of drawings was received. Applicants herein are submitting a complete set of drawings detailing all figures originally presented in this case. Additionally, Applicants are submitting changes consistent with 37 C.F.R. §1.83. In particular, Fig. 51 is bracketed to indicate a single entity, and the second dotted box presented in Fig. 58 has been removed.

The Examiner has objected to the drawings under 37 C.F.R. §1.83(a) for not showing the feature of an externally accessible opening, a massaging feature, a massaging structure or feature positioned behind the first external side, and the structures as called for by Claim 12. Applicants are at a loss to understand the Examiner's objections. The Examiner is respectfully reminded that 37 C.F.R. §1.83(a) states, "The drawing in a non-provisional application must show every feature of the invention specified in the claims. **However, conventional features disclosed in the description and claims, where a detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing...**"; to wit: Applicants' claim, "A semi-enclosed applicator." The claimed applicator comprises a first side, a second side, and an internal cavity. Applicants have provided illustrations of preferred embodiments (e.g., Figs. 1, 2, and 3) that illustrate exemplary semi-enclosed applicators. Fig. 1 shows cuff portion 21 and Fig. 2, a cross-sectional view of Fig. 1, depicts a hollow interior 29. Applicants respectfully believe that one of skill in the art would realize that Figs. 1 and 2, depicting a semi-enclosed applicator, indeed demonstrates a semi-enclosed applicator having an externally accessible opening.

The Examiner is respectfully reminded that claim language should not be construed in a lexicographic vacuum but in the context of the specification and drawings. *See Vitoro Co. v. White Consolidated Ind., Inc.*, 199 F.3d 1295; 53 U.S.P.Q. 2d 1065 (Fed.Cir. 1999). Further, it is fundamental that claims are to be construed in light of the specification and claims, and both are to be read with a view to ascertaining the invention. *See id.* (citing *Adams v. U.S.*, 383 US 39, 49; 86 S. Ct. 708 (1966)). Thus, Applicants believe that the externally accessible opening, as called for by Claims 1, 13, and 17; the massaging structure or feature, as called for by Claim 11; the massaging structure or feature positioned behind the first external side, as called for by Claim 11; and the structures, as called for by Claim 12, are sufficiently described to enable one of skill in the art to make and use Applicants' claimed invention. Therefore, Applicants respectfully request withdrawal of the Examiner's objection to the drawings.

Objections to the Specification

The Examiner has objected to Applicants' Specification for informalities. In particular, the Examiner asserts that the written description beginning on page 7, line 14, fails to describe the structure constituting a first side having a first internal surface and a first external surface and a second side having a second internal surface and a second external surface. Applicants respectfully direct the Examiner to the Specification on page 8, line 27-page 9, line 3.

Further, Applicants believe that the claimed subject matter has been described in the Specification in such a way as to enable one skilled in the art to make and/or use the invention. The Examiner is respectfully directed to Applicants' drawings (e.g., Fig. 2, 11, 13, 14, et al.) to provide Applicants' support for these claim limitations. Additionally, Applicants respectfully direct the Examiner's attention to settled Federal Circuit case law. The court, in *Martin v. Meyer*, 823 F.2d 500, 3 U.S.P.Q. 2d 1333 (Fed.Cir. 1987), stated, "It is not required that the application describe the claim limitations in greater detail than the invention warrants." The description must be sufficiently clear that persons of skill in the art will recognize that the applicant made the invention having those limitations. *Id.* Further, the court stated in *Fujikawa v. Wattanasin*, 93 F.2d 1559, 39 U.S.P.Q. 2d 1895 (Fed.Cir. 1996) that an *ipsis verbis* disclosure is not necessary to satisfy the written description requirement. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. *Id.* Additionally, M.P.E.P. §2173.05(f) states that, "A claim term which has no antecedent basis in the disclosure is not necessarily indefinite." Further, M.P.E.P. §2163(I)(B) states that, "There is no *in haec verba* requirement in regard to support of claim limitations."

In light of the plurality of well settled Federal Circuit case law and established PTO procedure, it is Applicants' position that Applicants' written description provides the necessary antecedent basis for Applicants' claimed subject matter. Therefore, based upon a fair reading of the Specification and Claims, Applicants respectfully request the Examiner withdraw these objections.

With regard to the Examiner's rejection to the disclosure for the noted informalities, Applicants have amended the Specification on page 7, line 7, and page 60, line 17 accordingly. However, the Examiner's objection to the Specification on page 40, line 10, leaves Applicants at a loss because the reported informality cannot be located. In light of these Amendments, Applicants respectfully request withdrawal of the Examiner's objection to the Specification.

Rejections Under 35 U.S.C. §112, ¶1

Claims 1-20 were finally rejected under 35 U.S.C. §112, ¶1 for not reasonably providing enablement for "at least one opening." Applicants traverse this objection. Again, Applicants respectfully direct the Examiner to the paragraph beginning on page 8, line 14, which states, "The term 'semi-enclosed applicator' is intended to refer to an applicator device having **at least one externally-accessible internal cavity for receiving a portion of a human anatomy....**" Applicants respectfully remind the Examiner that the written description must be sufficiently clear that persons of skill in the art will recognize that the applicant made the invention having those limitations. *See Martin v. Mayer*, 823 F.2d 500, 3 U.S.P.Q. 2d 1333 (Fed.Cir. 1987). Further, as discussed *supra*, Applicants believe the attached drawings to provide proper support under 35 U.S.C. §112. As such, drawings can provide a written description of an invention as required. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 U.S.P.Q. 2d 1111 (Fed.Cir. 1991). Thus, Applicants believe the instant Application to provide sufficient written description under 35 U.S.C. §112, ¶1 for the phrase "at least one opening." Applicants respectfully request the Examiner to withdraw this rejection.

Claims 1-20 were finally rejected under 35 U.S.C. §112, ¶1 for failure to describe "an activatable temperature changing element." Applicants traverse this rejection. Applicants respectfully direct the Examiner to the extensive elaboration as presented in the Specification beginning on page 33, line 27 to page 43, line 9. Because of this extensive disclosure, Claims 1, 13, and 17 are not directed to new matter. Applicants respectfully request withdrawal of this rejection.

Claims 1-20 have been finally rejected under 35 U.S.C. §112, ¶2 for not providing enablement for “a temperature changing element.” Applicants traverse this rejection. Applicants respectfully direct the Examiner to the Specification on page 38, lines 6-22, for the required disclosure. Applicants believe this disclosure provides enablement to one of skill in the art to make and practice the invention of Claims 1, 13, and 17. Applicants respectfully request the Examiner to withdraw this rejection.

Claims 3 and 4 have been finally rejected under 35 U.S.C. §112, ¶1 for failure to support a temperature changing element used for cleaning, moisturizing, conditioning or otherwise treating the skin, hair, or nails. Alternatively, the Examiner asserts the disclosure also fails to support an embodiment which utilizes a temperature changing element used with a product selected from the group consisting of face cleansers, body cleansers, toners, lotions, moisturizers, ointments, cosmetics/make-ups, medicaments, and related topically applied treatments. As noted above, Applicants have canceled Claim 3 and believe that this rejection has been obviated. With respect to Claim 4, Applicants respectfully refer the Examiner to the Specification on page 9, line 8 to page 50, line 4 for the required support. Applicants respectfully request withdrawal of the Examiner’s 35 U.S.C. §112, ¶1 rejection to Claim 1.

Additionally, Claims 4 and 5 have been finally rejected under 35 U.S.C. §112, ¶2 for Applicants’ use of “and combinations thereof” in Claim 4. Applicants respectfully direct the Examiner’s attention to the Specification on page 49, lines 12-14, for the required support. In particular, Applicants state that “such products are comprised of a single or plurality of ingredient components....” Applicants respectfully request withdrawal of the Examiner’s rejection to Claim 4.

Claim 12 was finally rejected under 35 U.S.C. §112, ¶1 for not enabling “balls, cylinders, rods.” Applicants respectfully traverse this rejection and are at a loss to understand the Examiner’s rejection. The Examiner is respectfully directed to the Specification beginning on page 52, lines 31-33. Specifically, Applicants state that “additional skin stimulation or surface abrasion may be provided from the applicator with the inclusion of a massaging structure or feature positioned behind the outer substrate....” Particularly, Applicants state that “this may take the form of a rigid pleated, corrugated, ribbed structure, ridged raised or recessed surface protrusions, void spaces or perforations within an otherwise solid flat structure, rotating or rolling balls/cylinders/rods, ...” Additionally, the Examiner is respectfully directed to Fig. 11, which provides an exemplary, enabled embodiment of the present invention claimed in Claim 12. Applicants respectfully request the Examiner’s withdrawal of this rejection to Claim 12.

Claim 14 has been finally rejected under 35 U.S.C. §112, ¶1 for incorporating new matter. Applicants respectfully traverse this rejection. As mentioned previously, Applicants respectfully direct the Examiner to the Specification on page 41, line 31 to page 42, line 2. Applicants state, "If the product is released onto the heating/cooling pouch 302, however, the heating/cooling pouch may be pressed against the target surface as the product is applied. Thus, **the actual contact of the heating pouch 302 to the surface** may provide an additional conductive heating/cooling effect." Thus, if actual contact of the heating pouch to the surface is to occur, one of skill in the art would realize that the heating/cooling pouch must be placed on said first external surface. Therefore, Applicants do not believe that Claim 14 is directed to new matter. Applicants respectfully request withdrawal of the Examiner's rejection to Claim 14.

Claims 17-20 have been finally rejected under 35 U.S.C. §112. Again, Applicants respectfully direct the Examiner to the Specification on page 42, line 31 to page 43, line 3. Applicants specifically state, "Alternatively, a heating/cooling element such as the pouch 302 may be located **internally in the reservoir 30** to allow for a combination of conductive and convective heat transfer...." Since Applicants believe this Claim to be directed to matter disclosed within the original Specification, it is not directed to new matter. Applicants respectfully request withdrawal of the Examiner's rejection to Claims 17-20.

Rejections Under 35 U.S.C. §112, ¶2

Claims 3 and 10 were rejected under 35 U.S.C. §112, ¶2 for reciting use without any active positive steps. By Amendment, Applicants have canceled Claims 3 and 10 herein and thereby request withdrawal of the Examiner's rejection

Claims 1 and 13 were rejected under 35 U.S.C. §112, ¶2 for providing terms lacking proper antecedent basis. Applicants have amended Claims 1 and 13 herein. Applicants respectfully request withdrawal of the Examiner's rejection under 35 U.S.C. §112, ¶2 to Claims 1 and 13.

Claim 5 was rejected under 35 U.S.C. §112, ¶2 for Applicants' use of the phrase "and the like." By Amendment, Applicants have removed this phrase from Claim 5 and respectfully request withdrawal of the Examiner's rejection to Claim 5.

Claim 15 has been rejected under 35 U.S.C. §112, ¶2 for failing to provide antecedent basis for the limitation "said rupturable pouch." By Amendment, Applicants have amended Claim 15 and respectfully request withdrawal of the Examiner's 35 U.S.C. §112, ¶2 rejection therefor.

Rejections Under 35 U.S.C. §103

Claims 1-7, 9, 10, 13, 15, and 16 have been finally rejected under 35 U.S.C. §103(a) over *Sansonetti*, U.S. Patent No. 4,087,675 in view of *Cahill*, U.S. Patent No. 3,116,732. Previous arguments regarding the *Sansonetti* reference will not be repeated for the sake of brevity. Applicants respectfully traverse this rejection for the following new reasons:

1. Applicants' invention requires the rupturable reservoir to be located proximate to the first internal surface of the semi-enclosed applicator.

2. Upon activation, Applicants' invention also requires that the product be released from the reservoir to the target surface **through the first side**.

3. Contrary to Applicants' claimed invention, *Sansonetti* places a reservoir 18 in the inner mitten 12. *See* Col. 2, lines 27-28. The inner mitten 12 is constructed of a liquid impervious material, such as plastic or the like. *See* Col. 2, lines 23-26.

4. Placing a reservoir internal to a liquid impervious mitten would clearly prevent disposal of the material contained within the reservoir to an external surface, much less through a liquid impervious material. This is consistent with the primary object of *Sansonetti's* objective of providing a heated mitten for use in conjunction with a hand cream or the like to facilitate absorption by a hand inserted **within the mitten**. *See* Col. 1, lines 39-42.

5. Thus, even if the *Cahill* rupturable pouch is combined with the *Sansonetti* impervious mitten, one of skill in the art would not be motivated to provide a rupturable pouch to dispense a product contained within a rupturable reservoir disposed on a first internal surface through the surface to an external target surface.

6. In fact, the *Sansonetti* reference is silent with respect to providing the disclosed materials to any external surface.

Because of these considerations, the *Sansonetti* and *Cahill* references do not suggest what Applicants claim as their invention. The *Sansonetti* or *Cahill* references, alone or in combination, fail to disclose, teach, suggest, or render obvious every recited feature of Applicants' claimed invention. Further, absent any motivation to provide any external deposition of a product contained within a mitten, the combination of the *Sansonetti* and *Cahill* references cannot render any of the rejected claims obvious. *See In re Fine*, 837 F.2d 1071 (Fed.Cir. 1988); M.P.E.P. §2143.01. Applicants therefore request reconsideration and withdrawal of the Examiner's 35 U.S.C. §103(a) rejection to Applicants' independent Claims 1, 13, and 17.

Because dependent Claims 2, 4-9, 11-12, 14-16, and 18-20 all depend directly or indirectly from Applicants' independent Claim 1, 13, or 17, they contain all of their respective limitations. For this reason, Applicants submit that the arguments made above concerning the allowability of Claims 1, 13, and 17 are equally applicable to the rejection of Claims 2, 4-9, 11-
Page 14 of 15

Appl. No. 10/089,351
Atty. Docket No. 8278
Amdt. dated September 25, 2003
Reply to Final Office Action dated July 28, 2003
Customer No. 27752

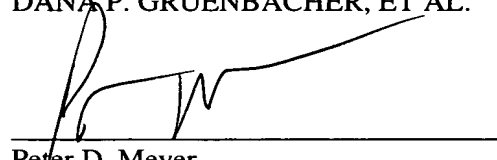
12, 14-16, and 18-20 under 35 U.S.C. §103(a). Applicants therefore request reconsideration and withdrawal of all 35 U.S.C. §103(a) rejection.

Conclusion

Based on the foregoing, it is respectfully submitted that each of Applicants' remaining claims is in condition for allowance and favorable reconsideration is requested.

Respectfully submitted,

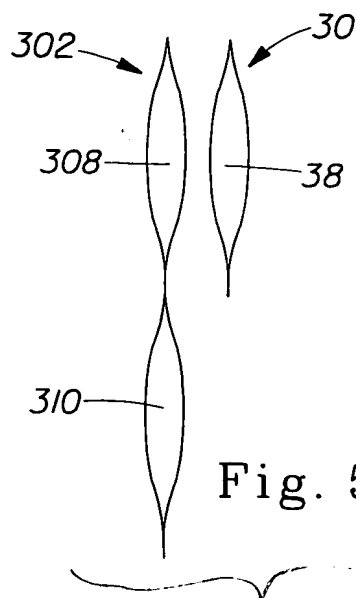
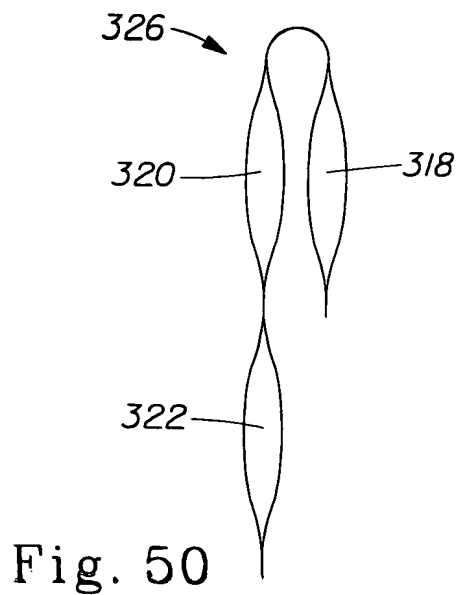
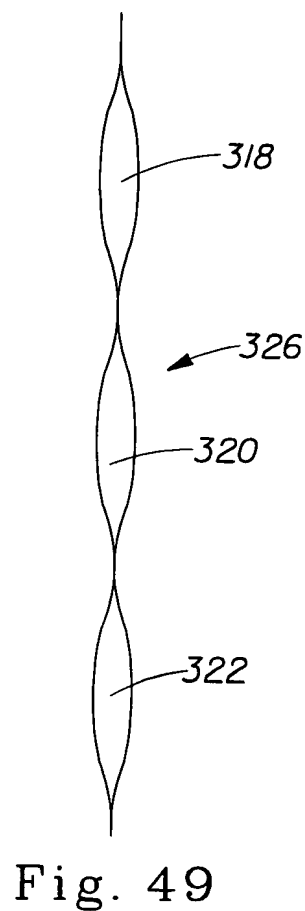
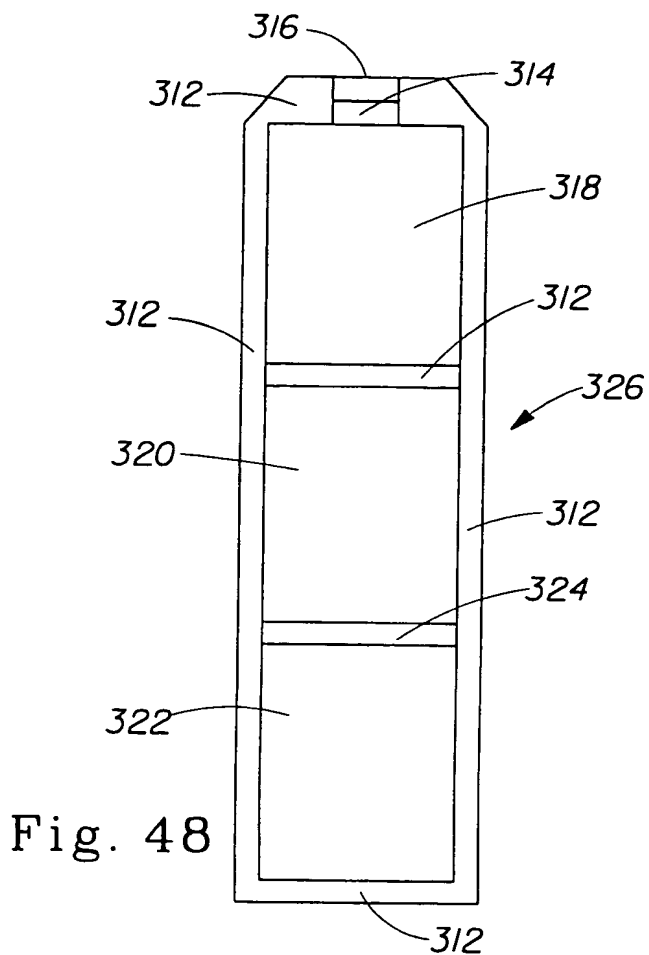
DANA P. GRUENBACHER, ET AL.

A handwritten signature in black ink, appearing to read 'Peter D. Meyer', is written over a horizontal line.

Peter D. Meyer
Attorney for Applicants
Registration No. 47,792
(513) 634-9359

September 25, 2003
Customer No. 27752

18/24



22/24

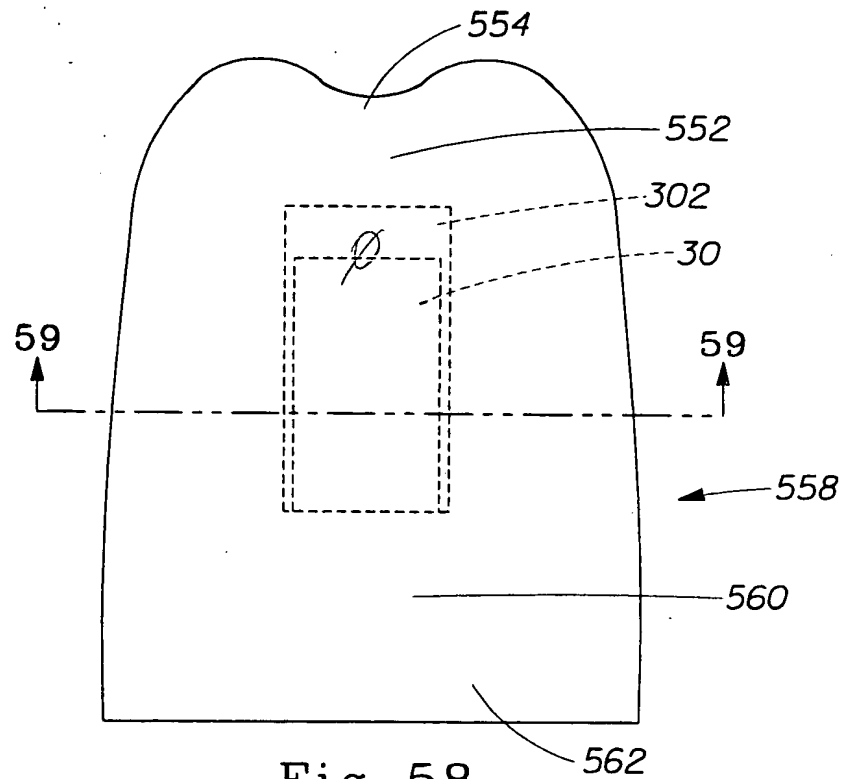


Fig. 58

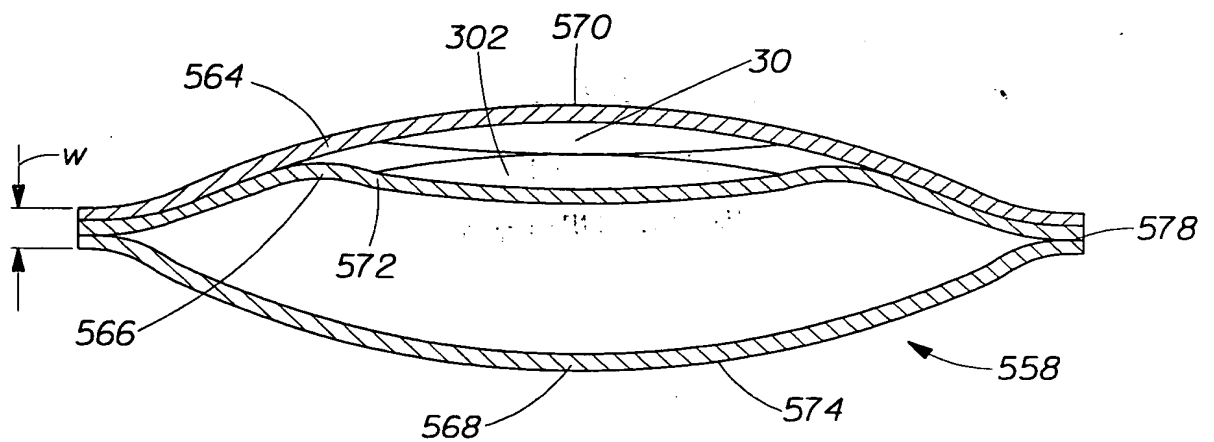


Fig. 59